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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/710,936

08/13/2004

David R. Hall

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38046

7590

06/26/2006

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EXAMINER

BATES, ZAKIYA W

ART UNIT

PAPER NUMBER

3676

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/710,936

Applicant(s)

HALL ET AL.

Examiner

Zakiya W. Bates

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>04192006</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claims 1-20 are objected to because of the following informalities: claim 1, the term --within--, or a suitable substitute, should be inserted after "disposed" in line 7.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 8-17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Vercaemer et al.

Vercaemer et al. discloses a system that includes an apparatus in a drill string, comprising: an internally upset drill pipe 12 comprising a first end, a second end, and an elongate tube intermediate the first and second ends, the elongate tube and the ends comprising a continuous inside surface with a plurality of inside diameters; a conformable metal tube 24, 26, 28 disposed within the drill pipe intermediate the ends thereof terminating adjacent to ends of the drill pipe; wherein the conformable metal

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tube substantially conforms to the continuous inside surface. With respect to the depending claims, the reference further teaches a non-uniform section, a corrosion resistant tube, a compression state of tube, a rough outer surface, the metal selected from the cited group of metals, a weld joint, a spiral non-uniform section 26, uniform end portions 29, the downhole component selected from the cited components, hydraulic pressure for expanding, a mandrel for expansion, the non-uniform section formed by roll forming or stamping (Fig. 10), and concave/convex regions.

4. Claims 1-6, 8-10, 12-14, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Koster.

Koster discloses an apparatus that includes an apparatus in a drill string, comprising: an internally upset drill pipe 32 comprising a first end, a second end, and an elongate tube intermediate the first and second ends, the elongate tube and the ends comprising a continuous inside surface with a plurality of inside diameters; a conformable metal tube 21 disposed within the drill pipe intermediate the ends thereof terminating adjacent to ends of the drill pipe; wherein the conformable metal tube substantially conforms to the continuous inside surface. With respect to the depending claims, the reference further teaches a non-uniform section, a corrosion resistant tube, a compression state of tube, a rough outer surface, the metal selected from the cited group of metals, a weld joint, the non-uniform section comprising convolutions, corrugations, flutes, indentations, or dimples having a thickness, a spiral non-uniform section, uniform end portions, the downhole component selected from the cited

components, hydraulic pressure for expanding, a mandrel 4 for expansion, the non-uniform section formed by roll forming or stamping, and insulating material.

5. Claims 1-3, 5, 6, 8-10, 12, 13, 17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dines et al.

Dines et al. discloses a downhole apparatus that includes an apparatus in a drill string, comprising: an internally upset drill pipe 80 comprising a first end, a second end, and an elongate tube intermediate the first and second ends, the elongate tube and the ends comprising a continuous inside surface with a plurality of inside diameters; a conformable metal tube 92 disposed within the drill pipe intermediate the ends thereof terminating adjacent to ends of the drill pipe; wherein the conformable metal tube substantially conforms to the continuous inside surface. With respect to the depending claims, the reference further teaches a non-uniform section, a corrosion resistant tube, a compression state of tube, a rough outer surface, the metal selected from the cited group of metals, a weld joint, the non-uniform section comprising convolutions, corrugations, flutes, indentations, or dimples having a thickness, the downhole component selected from the cited components, a mandrel 94 for expansion, the non-uniform section formed by roll forming or stamping, insulating material, concave/convex regions and ring 98.

6. Claims 1-3, 5, 6, 8-12, 15, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (2003/0178197)

Smith et al. discloses an apparatus that includes an apparatus in a drill string, comprising: an internally upset drill pipe 12 comprising a first end, a second end, and an

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elongate tube intermediate the first and second ends, the elongate tube and the ends comprising a continuous inside surface with a plurality of inside diameters; a conformable metal tube 16 disposed within the drill pipe intermediate the ends thereof terminating adjacent to ends of the drill pipe; wherein the conformable metal tube substantially conforms to the continuous inside surface. With respect to the depending claims, the reference further teaches a non-uniform section 38, a corrosion resistant tube, a compression state of tube, a rough outer surface, the metal selected from the cited group of metals, a weld joint, the non-uniform section comprising convolutions, corrugations, flutes, indentations, or dimples having a thickness, uniform end portions, the downhole component selected from the cited components, a mandrel 24 for expansion, one or more dies 40, the non-uniform section formed by roll forming or stamping, and an insulating material.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dines et al., Smith et al., or Koster in view of Hiraide et al.

Dines et al., Smith et al., and Koster all teach apparatuses as stated above. However, the references fail to teach the insulating material resists galvanic corrosion as called for in the claim.

Hiraide et al. teaches the use of galvanic corrosion resistant insulation for pipes for the purpose of providing a high corrosion prevention pipe.

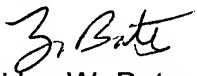
It would have been considered obvious to one of ordinary skill in the art at the time the invention was made to have provided galvanic corrosion resistant insulating material in view of Hiraide et al. in order to provide a high corrosion prevention pipe.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya W. Bates whose telephone number is (571) 272-7039. The examiner can normally be reached on Monday-Friday, 8:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Zakiya W. Bates
Primary Examiner
Art Unit 3676

zb
June 22, 2006